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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/178,329	10/23/1998	MICHAEL R. NOWAK	053649-0003	4360

7590

07/05/2005

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EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/178,329

Applicant(s)

NOWAK ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8-12,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8-12,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/25/05 has been entered. Claims 1, 5-6, 8-12 and 22-23 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 1, 5-6, 8-12 and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "A composite wrap material for wrapping a ream of paper, the wrap material consisting of: a first inner layer...; a second outer layer...; an adhesive layer...; a ream of paper; said composite wrap material wrapped around said ream of paper." Considering the claims are directed to "A composite wrap material" wherein the wrap material is "for wrapping a ream of paper", it is unclear how the wrap material can consist of the ream of paper as recited. From the limitations added in the amended claim, it appears as if the Applicant's intent is to claim the wrapped ream of paper and not the composite wrap. However, considering the claims still recite "A composite wrap material", it appears as if the limitations with regards to the ream of paper and the positioning of the wrap material about the ream of paper constitute intended use of the claimed wrap material and are not part of the

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claimed structure of the wrap material. Hence, it is unclear what invention the Applicant is claiming.

Claim Rejections - 35 USC § 102

4. Claims 1, 5, 6, 8, 10, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson et al (USPN 3,862,869.) Peterson et al teach a polyolefin-paper laminate comprising a paper base sheet, such as bleached paper, glassine paper or kraft paper, with a preferred basis weight of from 25 pounds per 3,000 sq. ft. upward to 100 pounds per ream; laminated to a preformed, oriented polyolefin film via a hot melt polyolefin adhesive layer, wherein the polyolefins may be polypropylene, polyethylene or copolymers thereof (Abstract; Col. 2, lines 4-68; Col. 3, lines 3-23; Examples; Claims.)

5. Claims 1, 6, 8, 9, 10, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Eberl (USPN 3,010,860.) Eberl teaches a composite packaging material comprising a wax paper having a ream weight of from 16 to 25 pounds, laminated to a synthetic resin film which may be preformed and is preferably a polyolefin such as polypropylene, wherein upon heating an interfacial commingling layer of the polyolefin and the wax is produced and serves as an adhesive layer to laminate the two (Col. 2, lines 10-57; Col. 3, lines 3-64.)

Claim Rejections - 35 USC § 103

6. Claims 1, 5, 6, 8-12 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finestone et al (USPN 5,244,702) for the reasons recited in the prior office action and restated below, wherein the Examiner notes that the instant claims are directed to the composite wrap material and not the wrapped ream of paper and hence the limitations with respect to

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“inner” and “outer” recited in Claim 1 and the positional limitations recited in Claims 22-23 constitute intended use and do not provide any patentable weight with respect to the composite.

Finestone et al teach a paper-plastic laminate sheet capable of being converted by conventional equipment into envelopes, grocery bags, and other dilatable container products that initially are in a flat state and are normally made of paper and wherein the products produced are waterproof and the paper facing has an affinity for standard printing inks (Abstract; Col. 2, lines 10-26.) The laminate consists of a paper facing sheet laminated via an adhesive layer to a reinforcing film of oriented polymer such as polypropylene wherein the paper may be of any gauge, weight and quality as appropriate to the end use for which the sheeting is intended such as unbleached Kraft paper, white or colored paper or coated paper (Abstract; Col. 2, lines 66-Col. 3, line 9.) The adhesive layer is preferably a water-based polyacrylate copolymer adhesive or any other water-based adhesive having similar bonding properties and having an affinity both for the paper sheet and the plastic film wherein hot melt adhesives would diminish the reinforcing characteristics of the film (Col. 3, lines 28-38.) Finestone et al do not teach that the paper has a basis weight of 20-60 lb/3000 sq ft as instantly claimed, however, Finestone et al do teach that the basis weight may be selected to be appropriate for a particular end use and that the laminate is suitable for products typically produced from flat paper materials, hence, given that ream wrap material is a typical product produced from flat paper materials, it would have been obvious to one having ordinary skill in the art at the time of the invention to determine the optimum basis weight based on the particular end use wherein basis weights within the instantly claimed range are known for producing ream wrap materials. Further, Finestone et al does not specifically teach adhesives as instantly claimed or metallization of the plastic film or the paper sheet,

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however, one having ordinary skill in the art at the time of the invention would have been motivated to provide a conventional metallized layer to improve barrier properties of the packaging laminate as is well known in the art and to further select from conventional adhesives utilized to bond paper and polymer layers such as those instantly claimed in producing the laminate taught by Finestone et al. In terms of instant Claim 10, the Examiner notes that though Finestone et al teaches away from utilizing heat when producing the laminate, the limitation "hot melt adhesive" is a process limitation wherein the adhesive layer in the final film is not actually hot. Therefore, considering the polyacrylate copolymer taught by Finestone et al as suitable in water-based form may also be characterized as a "hot melt adhesive" in other applications and considering the "hot" limitation is a process limitation, the Examiner takes the position that the invention taught by Finestone et al reads upon the final product of Claim 10 considering the final products appear to be the same.

Response to Arguments

7. Applicant's arguments filed 5/25/05 have been fully considered but they are not persuasive. The Applicant argues that the composite taught by Finestone et al has an exterior paper layer surface and an interior film layer surface while in the instant invention the paper layer is the interior layer that touches against the ream of paper and that the instant invention includes the ream of paper wrapped in the composite wrap. However, as recited above, the Examiner notes that the instant claims are directed to the composite wrap, not the wrapped ream of paper and hence the limitations with respect to the ream of paper and the positioning of the wrap material with respect to the ream constitute intended use. In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural

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difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, as recited above, the Examiner notes that the instant claims are directed to the composite wrap material and not the wrapped ream of paper and hence the limitations with respect to “inner” and “outer” recited in Claim 1 and the positional limitations recited in Claims 22-23 constitute intended use and do not provide any patentable weight with respect to the composite considering the composite taught by Finestone et al is structurally capable of performing the intended use.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ilnyckyj et al (USPN 3,496,062) teaches a wax composition for laminating paper to polyethylene film. Knauf (USPN 5,175,978) teaches a wrapper paper comprising a polyethylene layer and further teaches that known prior art ream wrappers are formed from polyethylene-paper laminates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson
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June 27, 2005